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PRE-APPEAL BRIEF REQUEST FOR REVIEW

Docket Number (Optional)	
MAT-3720US4	
Application Number	Filed
09/632,139	**August 3, 2000**
First Named Inventor	
Ryoichi IMANAKA	
Art Unit	Examiner
2424	**Rueben M. Brown**

Applicant requests review of the final rejection in the above-identified application. No amendments are being filed with this request.

This request is being filed with a notice of appeal.

The review is requested for the reason(s) stated on the attached sheet(s).
Note: No more than five (5) pages may be provided.

I am the

☐ applicant/inventor.

☐ assignee of record of the entire interest.
See 37 CFR 3.7.1 Statement under 37 CFR 3.73(b) is enclosed.
(Form PTO/SB/96)

☒ attorney or agent of record.
Registration number **34,515**

☐ attorney or agent acting under 37 CFR 1.34.
Registration number if acting under 37 CFR 1.34 _____

Signature

Lawrence E. Ashery
Typed or printed name

610-407-0700
Telephone number

July 2, 2009
Date

NOTE: Signatures of all the inventors or assignees of record of the entire interest or their representative(s) are required. Submit multiple forms if more than one signature is required, see below*.

☒ *Total of **1** forms are submitted

Claims 14, 17-19, 21-22, 37, 40, 42, 45, 47, 49, 51, 53, 55 and 57 have been rejected under 35 U.S.C. § 103(a) as being unpatentable over Horton (U.S. Patent No. 4,945,563) in view of Brownstein (U.S. Patent No. 5,671,202) and Cohen (U.S. Patent No. Patent No. 4,949,187). It is respectfully submitted, however, that these claims are patentable over the art of record for the reasons set forth below.

Applicant has previously amended his claims to include "on-demand programming." Cohen was then added to the previous combination of references. Cohen discloses "on-demand programming."

Applicant's invention, as recited by claim 14, includes a feature which is neither disclosed nor suggested by the art of record, namely:

> ... a provider for receiving signaling from a recipient ... and for providing said information to said recipient responsive to said signaling ...
>
> ... charging a different amount for providing said information to said recipient ...
>
> ... providing said information to said recipient responsive to said signaling ...

The combination of a) providing information to a recipient responsive to signaling; and b) charging a different amount for providing the information (based on whether or not the information is recorded) is not disclosed in the art of record. The only type of signals that Horton discloses is the receipt of broadcast signals. Horton also discloses the receipt of broadcast signals in real time. Cohen discloses a system where movie viewing is possible only after the movie has been downloaded. One of ordinary skill in the art could not combine the references to obtain a system where information is downloaded "on-demand" and then different amounts are charged

depending upon whether the information (which has been downloaded "on demand") is recorded at the receiver.

To Summarize:

Horton: Charging different amounts for broadcasted signals.

Cohen: "on demand"

The ability to charge different amounts to "on-demand" programming depending upon whether or not "on demand" programming is being recorded is lacking from the references. To be clear, if Applicant's claim related to the charging of different amounts depending upon whether a program is recorded, the Applicant would understand the Examiner's rejection. The rejection is being appealed because Applicant's claim relates to the charging of different amounts (depending upon whether recording is/will be occurring) for content that is viewed "on-demand."

KSR requires an explanation of why one skilled in the art would combine references. The explanation for combining the references provided in the Official Action is merely conclusory based on hindsight. Applicant's claimed features provide a synergy which the prior art lacks.

Accordingly, claim 14 is patentable over the art of record. The remaining independent claims set forth above, while not identical to claim 14, include language similar to the language set forth in claim 14. Thus, the above independent claims are patentable over the art of record for reasons similar to those set forth above with regard to claim 14.

In view of the amendments and arguments set forth above, the above-identified application is in condition for allowance, which action is respectfully requested.

FP_465114